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KENNETH R. GLASER MICHAEL E. MARTIN GARDERE WYNNE SEWELL LLP 1601 ELM STREET, SUITE 3000 DALLAS, TX 75201				
EXAMINER				
HOLLOWAY III, EDWIN C				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,748

Applicant(s)

WAGGAMON ET AL.

Examiner

Edwin C. Holloway, III

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

EXAMINER'S RESPONSE

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-22-09 has been entered. Claims 13-15 are pending. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 13, "receiver being of a type comprising..." makes it unclear if the claim is limited to such or is only of a similar type. Further, it is unclear what structure in the transmitter provides the claimed receiver limitations. In particular, it is unclear what transmitter structure would cause the receiver to "independently" generate a secret key.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support is lacking for at least "in the absence of said predetermined relationship, performing another non-linear decoding function on the intercepted hopping code using a different one of said stored secret keys to generate another second synchronization value, and continually repeating the sequence until a second synchronization value is found which bears the said predetermined relationship with said stored synchronization value." Applicant should specifically point out support in the original disclosure for the new or amended claims. See MPEP 714.02 and 2163.06.

Claim Rejections - 35 USC § 102 and 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Bruwer '904 (US 5868904).

Regarding claim 13, Bruwer '904 discloses a transmitter (10,11) for remotely transmitting a coded command signal to a receiver (12,13) associated with a barrier opening and closing operator (col. 1 lines 22-23), the receiver being of a type comprising a processor (controller 31 may be microprocessor in col. 22 lines 20-24) operable between a learn mode and an operate mode (col. 11 lines 48-55) and having a manufacturer's key stored therein designating a particular manufacturer (manufacturer's master key storage 40, col. 20 line 61),

(a) said transmitter having associated therewith said manufacturer's key, a transmitter identifying code (parameter set 56) unique to that transmitter comprising at least a secret key code portion (64) and a serial number code portion (62), and a non-linear function generator (18) for generating a multi-bit hopping code that changes each time the transmitter is actuated (col. 7 lines 30-33 and col. 14 line 19 - col. 16 line 12),

(b) said transmitter, when actuated during the said learn mode, transmitting to the receiver a coded signal representative of the said hopping code and the said serial number code portion (col. 11 lines 42-47), the received transmitted serial number portion in combination with the receiver - stored manufacturing key causing said receiver to

independently generate at least a secret key (col. 8 lines 11-19, col. 12 lines 55-64) that corresponds to the secret key code portion of said transmitter, the so-generated secret key being randomly stored in memory (key generated in RAM in col. 9 lines 55-67) in the receiver, and

(c) said transmitter, when subsequently actuated during the said operate mode, transmitting the hopping code to the receiver and causing the receiver to perform a non-linear decoding function on the intercepted hopping code using the so-generated secret key stored in memory in the receiver. (col. 11 line 35 - 65).

Regarding claim 14, Bruwer discloses storing hopping code information or parameter set in available locations of memory during the learn mode (col. 17 line 26 - col. 18 line 2 and col. 19 line 37 - col. 20 line 35). Available locations are considered to be unused. The selected location can be managed by a variety of schemes including cycling through locations and allowing the user to choose. The limitation of replacing information if all locations are used need not be given weight because it is claimed in the alternative. Further, replacing information is disclosed in col. 2 lines 2-21 of Bruwer.

Regarding claim 15, a synchronization value code portion changing each time button pressed is provided by the counter information 66 from counter storage 16 activated by buttons 48 to indicate number of times used in col. 11 lines 28-41 and col. 12 lines 6-24 and is compared a stored count in the receiver (col. 12 lines 41) to generate a command signal if they match.

Further, the receiver limitations of claims 13-15 need not be given weight because

claims are directed to the transmitter.

9. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruwer'904 (US 5686904) as applied above in combination with Roesgen (US 4800524).

Regarding random storing or replacing, user input in Bruwer may be random, such as direct input on a keypad or buttons such as car stereo presets. Cycling through memory may also be random. But random is not expressly disclosed in Bruwer. The limitation of randomly replacing information if all locations are used need not be given weight because it is claimed in the alternative. Further, replacing information is disclosed in col. 2 lines 2-21 of Bruwer.

Roesgen discloses an analogous art memory with pointer that may be accessed consecutively or in a random manner. See col. 1 lines 35-48.

Regarding claims 6 and 8-12, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Bruwer '904 randomly storing or replacing information in view of Roesgen disclosing accessing such memory in a random order scheme that is suggested by Bruwer disclosing next learning pointer can be managed according to a variety of different schemes.

10. Claims 6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruwer'904 (US 5686904) as applied above in combination with Sullivan (US 4484262).

Regarding random storing or replacing, user input in Bruwer may be random, such

as direct input on a keypad or buttons such car stereo presets. Cycling through memory may also be random. But random is not expressly disclosed in Bruwer. The limitation of randomly replacing information if all locations are used need not be given weight because it is claimed in the alternative. Further, replacing information is disclosed in col. 2 lines 2-21 of Bruwer.

Sullivan discloses an analogous art shared memory device that randomly distributes information from a plurality of sources S to a plurality of memory units U. The plural sources and plural memory units correspond to the to the plural transmitters and plural memory banks of Bruwer. Random number generator 426 and distributor 421 may provide the random distribution (fig. 4). See the abstract and col. 5 line 57 - col. 6 line 20.

Regarding claims 6 and 8-12, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Bruwer '904 randomly storing or replacing information in view Sullivan disclosing random distribution of information from plural sources to plural memory units that is suggested by Bruwer disclosing memory with a plurality of blocks for storing information from a plurality of source transmitters using a next learning pointer that can be managed according to a variety of different schemes.

11. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruwer'904 (US 5686904) in combination with Roesgen (US 4800524) or Sullivan (US

4484262) as applied above and further in view of Heitschel '118 (US 4750118) or Heitschel '986 (US00RE37986E).

Heitschel'118 discloses an analogous art GDO receiver with random access memory (RAM) in CPU 44 for storing transmitter codes. If all memory location have been used, storing a new code will erase or overwrite at least one old code. See col. 4 lines 58-68. Heitschel '968 is a reissue of Heitschel '118 and includes selecting a memory address to be erased if all location are used in claim 24.

If replacing information if the memory is full is required by the claims, then such would have been obvious in view of Heitschel '119 or '986 and suggested by the replacing in Bruwer.

Regarding claim 15, if repeating the sequence with different keys is not clear in the combination applied above, then it would have been obvious in view of Heitschel '119 or '986 disclosing cycling through each stored code in order to allow operation in response to any one of the learned transmitters.

12. Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bruwer'904 (US 5686904) in combination with Roesgen (US 4800524) or Sullivan (US 4484262) and Heitschel '118 (US 4750118) or Heitschel '986 (US00RE37986E) as applied above and further in view of Bruwer '187 (US005517187) or Bruwer '312 (US 6175312).

If the sync window is not clear in Bruwer '904 then it would have be obvious in view of Bruwer '187 or Bruwer '312 to allow a range of matches and suggested because

Bruwer '904 is a CIP of Bruwer '312 and Bruwer '904, with incorporation by reference to at least Bruwer '312.

Response to Arguments

13. Applicant's arguments filed 5-22-2009 have been fully considered but they are not persuasive and/or moot in view of new grounds of rejection.

The argument that the new claims overcome the cited and applied art is not persuasive for the reasons stated in the rejections made above.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Zimmerman, can be reached on (571) 272-3059.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/4/2009
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/Edwin C. Holloway, III/
Primary Examiner, Art Unit 2612